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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,812	08/05/2003	Martin L. Hage	110000-9410	8827
37374	7590	11/18/2005	EXAMINER	
INSKEEP INTELLECTUAL PROPERTY GROUP, INC 2281 W. 190TH STREET SUITE 200 TORRANCE, CA 90504			SHOSHO, CALLIE E	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 11/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/635,812

Applicant(s)

HAGE, MARTIN L.

Examiner

Callie E. Shosho

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. All outstanding rejections except for those described below are overcome by applicants' amendment filed 8/29/05.

The new grounds of rejection set forth below are necessitated by applicants' amendment and thus, the following action is final.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 and claim 14 have each been amended to recite that the ink is "both removable and opaque". It is the examiner's position that this phrase fails to satisfy the written description requirement under the cited statute since there does not appear to be a written description requirement of the cited phrase in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163. Applicant has not pointed to any portion of

the specification, and examiner has not found any support for this phraseology in the specification as originally filed.

With respect to the phrase the ink is “removable”, it is noted that while there is support in paragraph 42 of the present specification to recite that the ink is removable by 2-propanol or aqueous anionic detergent, there is no support to broadly recite that the ink is removable which encompasses all means, i.e. chemical or physical, that remove the ink for which there is no support in the specification as originally filed.

4. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for ink that is removable by 2-propanol or aqueous anionic detergent, does not reasonably provide enablement for ink that is removable by any means. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Case law holds that applicant’s specification must be “commensurately enabling [regarding the scope of the claims]” *Ex Parte Kung*, 17 USPQ2d 1545, 1547 (Bd. Pat. App. Inter. 1990). Otherwise **undue experimentation** would be involved in determining how to practice and use applicant’s invention. The test for undue experimentation as to whether or not all compounds within the scope of claims 1-16 can be used as claimed and whether claims 1-16 meet the test is stated in *Ex parte Forman*, 230 USPQ 546, 547 (Bd. Pat. App. Inter. 1986) and *In re Wands*, 8 USPQ2d 1400, 1404 (Fed.Cir. 1988). Upon applying this test to claims 1-16, it is believed that undue experimentation **would** be required because:

(a) *The quantity of experimentation necessary* is **great** since claims 1-16 read on ink that is removable by any type of removal means such as water, non-aqueous solution, cationic detergent, by scrapping or rubbing, etc.

(b) There is **no** *direction or guidance presented* for making an ink that is removable by any type of removal means such as water, non-aqueous solution, cationic detergent, by scrapping or rubbing, etc.

(c) There is an **absence** *of working examples* concerning making ink that is removable by any type of removal means such as water, non-aqueous solution, cationic detergent, by scrapping or rubbing, etc.

In light of the above factors, it is seen that undue experimentation would be necessary to make and use the invention of claims 1-16.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 and claim 14 have each been amended to recite that the ink is "removable". The scope of the claim is confusing because it is not clear what is meant by this phrase. It is not clear how, i.e. by means such as organic solvents, detergents, water, etc. or by rubbing, scrapping, etc.,

or when, i.e. after application to particular substrate, before or after drying, etc., the ink is removable.

Claim Rejections - 35 USC § 102

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1, 9-10, and 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Doshi '410 (U.S. 6,315,410).

The rejection is adequately set forth in paragraph 9 of the office action mailed 4/26/05 and is incorporated here by reference.

Further, it is noted that col.11, lines 14-15 and 50-51 of Doshi '410 disclose that the ink is opaque while col.21, lines 38-40 discloses that the ink is removable.

9. Claims 1 and 9-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Doshi et al. '676 (U.S. 2004/0130676).

The rejection is adequately set forth in paragraph 10 of the office action mailed 4/26/05 and is incorporated here by reference.

Further, it is noted that paragraphs 129 and 131 of Doshi et al. '676 disclose that the ink is opaque while paragraph 198 discloses that the ink is removable.

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10. Claims 1, 10, and 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Tucker et al. (U.S. 2003/0119943).

The rejection is adequately set forth in paragraph 11 of the office action mailed 4/26/05 and is incorporated here by reference.

Further, it is noted that paragraphs 41 and 43-44 of Tucker et al. disclose that the ink is opaque.

Although there is no explicit disclosure that the ink is removable, given the broad disclosure that the ink is removable, i.e. encompasses ink that is removable at any time by any means, and given that Tucker et al. disclose ink identical to that presently claimed, it is clear that the ink is inherently removable.

11. Claims 1-3, 7-9, and 14-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamazaki et al. (U.S. 2002/0017219).

The rejection is adequately set forth in paragraph 12 of the office action mailed 4/26/05 and is incorporated here by reference.

Further, it is noted that Yamazaki et al. disclose that the colorant used in the ink includes carbon black (paragraph 23) which would inherently result in opaque ink.

Although there is no explicit disclosure that the ink is removable, given the broad disclosure that the ink is removable, i.e. encompasses ink that is removable at any time by any means, and given that Yamazaki et al. disclose ink identical to that presently claimed, it is clear that the ink is inherently removable.

Claim Rejections - 35 USC § 103

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. Claims 2, 6, and 7-8 rejected under 35 U.S.C. 103(a) as being unpatentable over Doshi '410 (U.S. 6,315,410) in view of Yui et al. (U.S. 5,948,155)

The rejection is adequately set forth in paragraph 14 of the office action mailed 4/26/05 and is incorporated here by reference.

14. Claims 2, 6, and 7-8 rejected under 35 U.S.C. 103(a) as being unpatentable over Tucker et al. (U.S. 2003/01199430) in view of Yui et al. (U.S. 5,948,155)

The rejection is adequately set forth in paragraph 15 of the office action mailed 4/26/05 and is incorporated here by reference.

15. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doshi '410 (U.S. 6,315,410) or Tucker et al. (U.S. 2003/01199430) either of which in view of Souel et al. (U.S. 6,281,468).

The rejection is adequately set forth in paragraph 16 of the office action mailed 4/26/05 and is incorporated here by reference.

16. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamazaki et al. (U.S. 2002/0017219) in view of Valentini et al. (U.S. 2003/0184629).

The rejection is adequately set forth in paragraph 17 of the office action mailed 4/26/05 and is incorporated here by reference.

Response to Arguments

17. Applicants' arguments regarding JP 61-017101, JP 60-023092, EP 472496, JP 08112566, and Su et al. (U.S. 5,352,245) have been considered but they are moot in view of the discontinuation of the use of these references against the present claims.

18. Applicants' arguments filed 8/29/05 have been considered but, with the exception of arguments relating to JP 61-017101, JP 60-023092, EP 472496, JP 08112566, and Su et al., they are not persuasive.

Specifically, applicants argue that Doshi '410, Doshi et al. '676, Tucker et al., and Yamazaki et al. are not relevant references against the present claims given that there is no disclosure in any of the references that the ink is removable and opaque as now required in all the present claims.

However, with respect to Doshi '410, it is noted that col.11, lines 14-15 and 50-51 disclose that the ink is opaque while col.21, lines 38-40 discloses that the ink is removable.

With respect to Doshi et al. '676, it is noted that paragraphs 129 and 131 disclose that the ink is opaque while paragraph 198 discloses that the ink is removable.

With respect to Tucker et al., it is noted that paragraphs 41 and 43-44 disclose that the ink is opaque.

Although there is no explicit disclosure in Tucker et al. that the ink is removable, given the broad disclosure that the ink is removable, i.e. encompasses ink that is removable at any time by any means, and given that Tucker et al. disclose ink identical to that presently claimed, it is clear that the ink is inherently removable.

With respect to Yamazaki et al., it is noted that Yamazaki et al. disclose that the colorant used in the ink is carbon black which would inherently result in opaque ink.

Although there is no explicit disclosure in Yamazaki et al. that the ink is removable, given the broad disclosure that the ink is removable, i.e. encompasses ink that is removable at any time by any means, and given that Yamazaki et al. disclose ink identical to that presently claimed, it is clear that the ink is inherently removable.

In light of the above, it is the examiner's position that Doshi et al. '410, Doshi et al. '676, Tucker et al., and Yamazaki et al. remain relevant references against the present claims.

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Callie E. Shosho
Primary Examiner
Art Unit 1714